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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,282	04/22/2004	Eiichi Tabei	251240US0	7253

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EXAMINER

ZIMMER, MARC S

ART UNIT PAPER NUMBER

1712

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,282

Applicant(s)

TABEL ET AL.

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/08/04, 12/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsumura et al., U.S. Patent # 5,623,030. Tsumura discloses an interpenetrating network-forming composition comprising two sets of crosslinking materials that form an IPN when crosslinked in the presence of one another. Of particular relevance to the claimed invention are the combinations of compounds (B) and (C). Compound (B) is a compound bearing at least two SiH groups per molecule and is embodied by the materials outlined at the bottom of column 4 and in column 5. Compound (C) is a compound bearing at least two vinylsilyl groups per molecule and is embodied by the materials outlined in column 6 and the top of column 7. The skilled artisan will appreciate that any of the specific compounds (B) can be combined with any of the specific compounds (C). Moreover, as examples of compounds (B) and (C), there are mentioned cyclic siloxanes bearing hydrosilyl groups and vinylsilyl groups respectively. There are also mentioned as examples of compounds (B) and (C) aromatic compounds having hydrosilyl- and vinylsilyl groups respectively attached directly to a benzene ring. Platinum-based catalysts are combined with a mixture of (B) and (C) to promote a hydrosilylation reaction between them (column 8, lines 17-29).

As for claims 15 and 16, it is stated in column 8, lines 13-16 that the preferred ratio of Si-H groups to vinylsilyl groups is between 0.5 and 5, more preferably 0.8 and 2.

Claims 1-5, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by an abstract of an article entitled "Synthesis and some Properties of Poly[(phenylenesilcarbo)organocyclosiloxanes]" published in Vysokomolekulyarnye Soedineniya, Seriya A (1993), 35(5), pp 475-480. This reference discloses the preparation of polymers by hydrosilylating 1,3- or 1,5-divinylorganocyclotetrasiloxane with 1,4-bis(dimethylsilyl)benzene in the presence of chloroplatinic acid.

Allowable Subject Matter

Claims 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Tsumura discloses adding an alkoxy-functionalized silsesquioxane to the composition containing (B), (C), and a hydrosilylation catalyst. There is no obvious reason as to why one of ordinary skill would have been motivated to replace the silsesquioxane taught therein with an organosilicon resin having hydride or alkenyl groups

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 13, 2005

Marc Zimmer

Marc Zimmer

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